

Amendment and Response Under 37 C.F.R. §1.116 - Expedited Examining Procedure
Serial No.: 09/446,323
Confirmation No.: 2155
Filed: 20 March 2000
For: DEVICE FOR TAKING AND EXAMINING SAMPLES

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Remarks

The final Office Action of 9 September 2003 has been received and reviewed. With claims 1, 12, 19, 21, and 24 having been amended, and claim 3 having been canceled, the pending claims are claims 1, 2, 7, 8, and 10-26 (with claim 21 withdrawn from consideration). Reconsideration and withdrawal of the rejections are respectfully requested for at least the reasons set forth below.

Attorney Docket Number

Please note that the attorney Docket Number for this application has been changed from 258.0004 0101 to 309.00010101.

Telephonic Examiner Interview

Applicant's Representative (Matthew W. Adams, Reg. No. 43,459) appreciates the Examiner's time in discussing this application generally on 17 November 2003. Although no specific agreement was reached, Applicant believes the amendments made herein are sufficient to overcome the pending rejections and, additionally, that these amendments do not require extensive examination. Accordingly, it is respectfully requested that these amendments be entered and considered.

Amendments

Abstract

The Abstract has been amended as shown herein to overcome the Examiner's objections.

Claims

Claims 1, 12, 19, 21, and 24 are amended to further recite that the sample-taking means includes a sample chamber and a surplus chamber.

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Claim 12 has further been amended to recite a "sample-taking device" rather than a "sample-taking means." Claim 12 was further amended to correct a typographical error ("displaceable").

These amendments find support in the specification as originally filed. See, for example, page 7, lines 7-9 ("[t]he sample chamber contains an exactly defined amount, optional surplus sample material is contained in the rear part of the sample-taking means, i.e., the surplus chamber"), and the figures.

Specification Objection

The Office Action has again objected to the language used within the Abstract. In particular, the use of "means" language within the Abstract is objected to. While Applicant notes that the M.P.E.P. states that such phraseology as "means" and "said" "should be avoided," (M.P.E.P. § 608.01(b), emphasis added), this is not an absolute restriction to such use, i.e., there is no indication that this sort of language cannot be used. Nonetheless, Applicant has revised the Abstract to remove the objectionable language. Reconsideration and withdrawal of the objection are respectfully requested.

The 35 U.S.C. §102(b) Rejection

Claims 1, 3, 8, 10-12, 19-20, and 22 were rejected under 35 U.S.C. § 102(b) as being anticipated by Smith et al. (U.S. Patent No. 4,534,939). Applicant traverses this rejection for at least the following reasons. Claim 3 has been canceled, rendering its respective rejection moot.

Independent claims 1, 12, and 19 are amended as shown herein. In particular, these claims now recite that the sample-taking means (or sample-taking device of claim 12) includes a sample chamber and a surplus chamber. The Office Action equates the "sample-taking means" of the present invention to the syringe needle 102 of Smith et al., which does not include a sample chamber and a surplus chamber. As described in the specification, the surplus chamber provides various advantages including, for example, providing a volume for any surplus sample in excess of the predetermined sample chamber volume.

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As anticipation requires that a reference teach each and every element of the claim, withdrawal of the rejection of independent claims 1, 12, and 19 is respectfully requested. Moreover, claims 8, 10, 11, 20, and 22 are submitted to be allowable not only in view of their dependence, but also because of the particular subject matter recited therein.

Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

The 35 U.S.C. §102(e) Rejection

Claims 1-3, 8, 11, 12, 19, 20, 22, and 24-26 were rejected under 35 U.S.C. §102(e) as being anticipated by Hessel et al. (U.S. Pat. No. 6,048,735). Applicant traverses for at least the following reasons. While substantive remarks are provided below, Applicant does not admit that Hessel et al. is prior art and reserves the right to swear behind the document at a later date. Claim 3 has been canceled, rendering its respective rejection moot.

Independent claims 1, 12, 19, and 24 are amended as shown herein. As discussed above, these amended claims recite that the sample-taking means (or sample-taking device of claim 12) includes a sample chamber and a surplus chamber. The Office Action equates the "sample-taking means" of the present invention to "inside the cap 16" of Hessel et al. However, the inside of the cap 16 of Hessel et al. does not include a sample chamber and a surplus chamber.

As a result, Hessel et al. fails to anticipate independent claims 1, 12, 19, and 24. Moreover, claims 2, 8, 11, 20, 22, 25, and 26 are also submitted to be patentable in view of Hessel et al. as these claims depend from independent claims 1, 12, 19, and 24 and further include additional, distinct elements. Reconsideration and withdrawal of the rejection are, therefore, respectfully requested.

The 35 U.S.C. §103(a) Rejection

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. or Hessel et al. in view of Berger (U.S. Pat. No. 4,269,237). Applicant traverses for at least the following reasons.

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Claim 7 depends from claim 1 and thus includes all the elements of that claim. As discussed above, neither Smith et al. nor Hessel et al. teaches each and every element of claim 1 (see e.g., remarks above regarding inclusion of a sample chamber and a surplus chamber), nor do these documents *suggest* the missing claim elements. Nothing is identified within the teachings of Berger that remedies this deficiency. As a result, Applicant submits that Berger, in combination with either Smith et al. or Hessel et al., fails to render claim 7 obvious. Reconsideration and withdrawal of the rejection are thus requested.

Allowed Claims

Applicant notes the indication that claims 13-18 and 23 are allowable.

Withdrawn Claim 21

Although withdraw from consideration, claim 21 has been amended as indicated. Rejoinder of this non-elected method claim is respectfully requested upon allowance of the elected product claims. Notably, the non-elected method claim includes limitations of the elected product claims (see 1184 O.G. 86, citing *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 37 USPQ2d 1663 (Fed. Cir. 1996)).

The status identifier "withdrawn - currently amended" is utilized as permitted in claim 21, see, e.g., "Changes to Implement Electronic Maintenance of Official Patent Application Records," 1272 O.G. No. 5 (29 July 2003).

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Summary

It is submitted that pending claims 1, 2, 7, 8, and 10-26 are in condition for allowance and notification to that effect is requested. The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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4 December 2003
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MWA/kjm

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 4th day of December, 2003, at 12:45pm (Central Time).

By: Gina E. Olson
Name: Gina E. Olson
